UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,062	11/02/2001	Andrew Ishak	ISHAK-PA-1	9556

7590 06/29/2004

ROYAL W. CRAIG
LAW OFFICES OF ROYAL W. CRAIG
10 NORTH CALVERT STREET
SUITE 153
BALTIMORE, MD 21202

EXAMINER	
RAIZEN, DEBORAH A	

ART UNIT	PAPER NUMBER
2873	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/000,062	ISHAK, ANDREW	
	Examiner	Art Unit	
	Deborah A. Raizen	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2004 and 20 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6-8,10,12,14-17 and 20-23* is/are pending in the application.

4a) Of the above claim(s) *8,17 and 20-23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6,7,10,12 and 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 November 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I in Paper No. 0504 of May 20, 2004, is acknowledged.

2. Claims 8, 17, and 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 0504 of May 20, 2004.

3. In summary, the claims remaining under consideration are claims 1, 3, 4, 6, 7, 10, 12, and 14-16.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3, 4, 6, 7, 10, 12, and 14-16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. In claims 1 and 10, as newly amended, the limitation "angularly displaced" is recited. This limitation is not mentioned in the specification or in the priority documents. On page 15 of the specification, lines 9-10 recite: "each thin film layer being vacuum deposited separately in alternating 90 degree angles," and lines 13-14 recite: "stacked dielectric mirror layer 14 with particular constituents applied in alternating angular deposits." However, the specification does not disclose, explicitly or implicitly, that the thin film layers are angularly displaced.

8. Claims 3, 4, 6, and 7, which depend on claim 1, and claims 12, and 14-16, which depend on claim 10, inherit the limitations of their respective base claims, including "angularly displaced", and are therefore rejected as well.

9. Claims 1, 3, 4, 6, 7, 10, 12, and 14-16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 10, as amended, recite the limitation "angularly displaced thin film layers". The specification does not explain how such angularly displaced thin film layers can be formed. Lines 9-10 on page 15 disclose that "each thin film layer being vacuum deposited separately in alternating 90 degree angles." However, this disclosure is not sufficient because it is not clear

how such a process can result in angularly displaced thin film layers. Under conventional vacuum deposition method, the substrate (lens) is rotated to ensure homogeneous coating. The positions of the sources would then not have a different effect on the resulting structure (in the absence of a more detailed explanation of their orientations with respect to the substrate). Even if the substrate were held stationary, the resulting structure would have a non-uniform thickness of the layers, which would interfere with the function of the dielectric mirror rather than enhance it. It is also not clear that such a structure, with uneven layers, could be described as having "angularly displaced thin film layers".

10. Claims 3, 4, 6, and 7, which depend on claim 1, and claims 12, and 14-16, which depend on claim 10, inherit the limitations of their respective base claims, including "angularly displaced", and are therefore rejected as well.

11. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1, 3, 4, 6, 7, 10, 12, and 14-16 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term

"angularly displaced" in claims 1 and 10 appears to be used by the claims to mean "vacuum deposited separately in alternating 90 degree angles", while the accepted meaning is "having a different orientation". The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. (4,878,748, of record) in view of Sternbergh (5,694,240, of record).

In regard to claim 1, Johansen discloses a sunglass lens, comprising:

a first layer of ophthalmic plastic colorized with high-contrast blue-blocking amber-tint (Fig. 6 and col. 19, lines 66-67; col. 18, lines 44-51, Fig. 3, and col. 20, lines 9-10; combination dye 18, whose composition is specified in Fig. 3 and col. 20, lines 28-38 as consisting of a mixture of yellow and orange dyes, is amber colored; also, the compositions specified for filters that cut on at longer wavelengths, col. 20, lines 45-62 produces a darker amber color);

a second layer of ophthalmic plastic colorized with said high-contrast blue-blocking amber-tint (Fig. 6 and col. 19, lines 66-67; col. 18, lines 44-51, Fig. 3, and col. 20, lines 9-10);

a polarizing layer encapsulated between said first and second ophthalmic plastic layers (16 in Figs. 5, 6 and col. 19, line 57 to col. 20, line 5);

whereby said layers are arranged to provide a balanced light transmission profile in which substantially 100% of UV-A & B light is blocked to at least 400nm (col. 15, lines 57-59, which defines substantially blocking as blocking over 99 percent of incident radiation at each and every wavelength, which in turn meets the limitation "substantially 100%"; col. 16, lines 11-13; col. 20, lines 39-44), and average blue light transmission of said lens is less than 0.4% (curve C in Fig. 2 and col. 15, lines 57-59, col. 16, lines 11-16, col. 20, lines 45-50 disclose an average blue light transmission of less than 1% without the effect of the polarizer; when the effect of the polarizer is included the resulting average blue light transmission is 23% times 1%, which is 0.23%; the effect of the polarizer is estimated from the disclosure that the polarizer blocks 80% or more of the horizontally polarized incident radiation, col. 15, lines 60-62 and col. 15, lines 32-33, and by using equations 5a-5c in col. 8 to calculate that when the angle of incidence is 45°, corresponding to mid-afternoon, only 3.7% of light reflected off water is vertically polarized).

However, Johansen does not disclose a multilayer dielectric mirror. Sternbergh discloses a sunglass lens that has a multilayer dielectric mirror for reducing glare and overall light transmission (composite layer 3 in Figs. 1 and 2, col. 3, lines 6-13 and 45-67, col. 4, lines 45-46, and Table 1 col. 3, lines 47-54 col. 4, lines 10-21), said dielectric mirror comprising a plurality of angularly displaced (the limitation "angularly displaced" is ignored because it is new matter and because it does not appear to be a feature of applicant's invention, as explained above for the rejections under 35 U.S.C. §112, first paragraph) thin film layers (col. 3, lines 55-67 and Tables 1, 2, or 3). Sternbergh further discloses that substrate material for the dielectric mirror can be chosen from a wide range, including colored (col. 5, line 56) plastics (col. 5, line 58)

Furthermore, Sternbergh discloses that the average blue light transmission through the dielectric mirror in the region 400 to 490 nm is about 46%, as can be calculated from Fig. 3. When such a coating is applied to the Johansen, the resulting lens would have an average blue light transmission of 46% times 0.23%, which is 0.1%.

Johansen also teaches that blue light is harmful and that it is important to block blue light from reaching the eye (col. 7, lines 25-27). Fig. 3 of Sternbergh shows that the Sternbergh dielectric mirror blocks some of the blue light. Also, the dye molecules used to block ultraviolet and blue light in the Johansen lens (col. 18, lines 15-17 and Fig. 3) would decompose as a result of long term exposure to high levels of ultraviolet light. Blocking some of the ultraviolet light with the Sternbergh dielectric mirror would help prolong the lifetime of the dyes in the Johansen lens. Therefore, it would have been obvious to one of ordinary skill in the art to add a dielectric mirror as disclosed by Sternbergh to the Johansen lens because it would further block blue light, a desirable goal as taught by Johansen, and because it would help prolong the lifetime of the dyes in the Johansen lens by blocking ultraviolet light from reaching the dyes.

In regard to claim 3, in the Johansen sunglass lens, the first and second layers are CR-39® plastic (col. 16, lines 30-35).

In regard to claim 6, Sternbergh discloses that the multi-layered dielectric mirror further comprises at least six thin film layers (col. 3, line 59) vacuum deposited (col. 4, lines 1-3: physical vapor deposition and chemical vapor deposition are types of vacuum deposition) atop said first layer of ophthalmic plastic (Table 3 in col. 5 discloses an embodiment in which the thin

film layers C-1 to C15 are deposited directly on the substrate) for further reducing light transmission and glare (col. 3, lines 45-67 and col. 4, lines 10-28).

Furthermore, Sternbergh teaches that a structure of at least nine alternating layers is preferred because it optimizes UV blocking (col. 3, lines 59-60 and col. 4, lines 30-36). Also, Sternbergh teaches that vacuum deposition is the method for making the dielectric mirror (col. 4, lines 1-3). If the Sternbergh dielectric mirror were provided on the Johansen lens, it would be in accordance with Table 3 of Sternbergh because the intervening absorbing layer of Tables 1 and 2 would not be necessary.

Therefore, it would have been obvious to one of ordinary skill in the art to construct the dielectric mirror of Sternbergh on the Johansen lens by vacuum depositing at least six thin film layers atop the first layer of ophthalmic plastic because that is the conventional method for constructing such a mirror and because more than six layers provide optimum UV blocking, as taught by Sternbergh.

16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh and further in view of Larson (6,334,680, of record) and further in view of Gupta et al. (5,702,819, of record). Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh for the reasons set forth above. However, Johansen does not disclose that the first and second layers are polycarbonate.

Larson discloses a coated, tinted ophthalmic lens that is constructed with a polarizing film between layers of polycarbonate (col. 5, lines 55-60). Furthermore, Gupta teaches that polycarbonate provides impact resistance (col. 1, lines 36-37). Therefore, it would have been

obvious to one of ordinary skill in the art to form the lens of Johansen in view of Sternbergh with first and second layers that are polycarbonate, as disclosed in Larson, because polycarbonate would provide impact resistance, as taught by Gupta.

17. Claim 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh and further in view of Evans et al. (6,220,703, of record). Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh for the reasons set forth above. However, Johansen does not disclose that the polarizing filter layer is molecularly bonded between the first and second ophthalmic plastic layers to avoid haze and delamination.

Evans discloses a lens in which a polarizing layer is molecularly (understood as chemically) bonded (col. 5, lines 1-53) between first and second ophthalmic plastic layers (col. 2, lines 51-54). Furthermore, Evans teaches that the molecular bonding has the advantage of improving adhesion (col. 1, lines 61-67, col. 2, lines 22-32, and col. 5, lines 1-7 and 17-20). Therefore, it would have been obvious to one of ordinary skill in the art to molecularly bond the polarizing layer between the first and second ophthalmic plastic layers of the Johansen in view of Sternbergh lens because the molecular bonding would improve adhesion, as taught by Evans.

18. Claims 10, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh and further in view of Larson (6,334,680, of record) and still further in view of Evans et al. (6,220,703, of record).

In regard to claim 10, Johansen discloses a sunglass lens, comprising: a third layer blue-blocking amber-tinted ophthalmic plastic material (Fig. 6 and col. 19, lines 66-67; col. 18, lines 44-51, Fig. 3, and col. 20, lines 9-10; the combination dye 18 for a cut-on wavelength at 550 nm, whose composition is specified in Fig. 3 and col. 20, lines 57-62 as consisting of a mixture of red and orange dyes, is amber colored); a fifth layer blue-blocking amber-tinted ophthalmic plastic material (Fig. 6 and col. 19, lines 66-67; col. 18, lines 44-51, Fig. 3, and col. 20, lines 9-10); a fourth polarizing layer ... sandwiched between [the third and fifth plastic layers] (Fig. 6 and col. 19, lines 66-67); whereby said layers are arranged to provide a balanced light transmission profile optimum for use on the water (Fig. 3 and col. 21, lines 33-40 and col. 22, lines 12-23) in which substantially 100% of UV-A & B light is blocked (col. 15, lines 57-59, which defines substantially blocking as blocking over 99 percent of incident radiation at each and every wavelength, which in turn meets the limitation "substantially 100%"; col. 16, lines 11-13; col. 20, lines 39-44) and at least 99% of blue light is blocked at up to 490 nm (col. 15, lines 57-59; col. 16, lines 11-13; col. 20, lines 39-44).

However, Johansen does not disclose a first layer hydrophobic overcoat and a second layer dielectric mirror. Johansen also does not disclose that the polarizing layer is molecularly bonded to the plastic layers.

Sternbergh discloses a layer on a sunglass lens that is a dielectric mirror for reducing light transmission and glare (composite layer 3 in Figs. 1 and 2, col. 3, lines 6-13 and 45-67, col. 5, lines 20-24, and layers C-1 to C-15 in Table 3), said dielectric mirror comprising a plurality of angularly displaced (the limitation "angularly displaced" is ignored for the reasons set forth above) thin film layers (col. 3, lines 55-67). Sternbergh further discloses that the substrate

material for the dielectric mirror can be chosen from a wide range, including colored (col. 5, line 56) plastics (col. 5, line 58). Furthermore, Sternbergh teaches that such a dielectric mirror has the advantage of blocking ultraviolet radiation while maintaining sufficient transmittance in the visible region (col. 1, lines 14-27).

Johansen also teaches that blue light is harmful and that it is important to block blue light from reaching the eye (col. 7, lines 25-27). Fig. 3 of Sternbergh shows that the Sternbergh dielectric mirror blocks some of the blue light. Also, the dye molecules used to absorb ultraviolet and blue light in the Johansen lens (col. 18, lines 15-17 and Fig. 3) would decompose as a result of long term exposure to high levels of ultraviolet light. Blocking some of the ultraviolet light with the Sternbergh dielectric mirror would help prolong the lifetime of the dyes in the Johansen lens. Therefore, it would have been obvious to one of ordinary skill in the art to add a dielectric mirror as disclosed by Sternbergh to the Johansen lens because it would further block blue light, a desirable goal as taught by Johansen, and because it would help prolong the lifetime of the dyes in the Johansen lens by blocking ultraviolet light from reaching the dyes.

Larson discloses a lens that has a first layer hydrophobic overcoat for protection from seawater and smudging (Fig. 13 and col. 1, lines 53-61). Furthermore, Larson teaches that such an overcoat has the advantage of making it easier to clean the lens (col. 1, lines 53-61). Therefore, it would have been obvious to one of ordinary skill in the art to provide a hydrophobic overcoat on the lens of Johansen in view of Sternbergh because such an overcoat would make it easier to clean the lens, as taught by Larson.

Evans discloses a lens in which a polarizing layer is molecularly (understood as chemically) bonded (col. 5, lines 1-53) between first and second ophthalmic plastic layers (col. 2,

lines 51-54). Furthermore, Evans teaches that the molecular bonding has the advantage of improving adhesion (col. 1, lines 61-67, col. 2, lines 22-32, and col. 5, lines 1-7 and 17-20). Therefore, it would have been obvious to one of ordinary skill in the art to molecularly bond the polarizing layer between the first and second ophthalmic plastic layers of the lens of Johansen in view of Sternbergh and Larson because the molecular bonding would improve adhesion, as taught by Evans.

In regard to claim 12, Sternbergh discloses that the multi-layered dielectric mirror further comprises at least six thin film layers (col. 3, line 59) vacuum deposited (col. 4, lines 1-3: physical vapor deposition and chemical vapor deposition are types of vacuum deposition) atop said third layer of ophthalmic plastic (Table 3 in col. 5 discloses an embodiment in which the thin film layers C-1 to C15 are deposited directly on the substrate) for further reducing light transmission and glare (col. 3, lines 45-67 and col. 4, lines 10-28).

Furthermore, Sternbergh teaches that a structure of at least nine alternating layers is preferred because it optimizes UV blocking (col. 3, lines 59-60 and col. 4, lines 30-36). Also, Sternbergh teaches that vacuum deposition is the method for making the dielectric mirror (col. 4, lines 1-3). If the Sternbergh dielectric mirror were provided on the Johansen lens, it would be in accordance with Table 3 of Sternbergh because the intervening absorbing layer of Tables 1 and 2 would not be necessary.

Therefore, it would have been obvious to one of ordinary skill in the art to construct the dielectric mirror of Sternbergh on the Johansen lens by vacuum depositing at least six thin film layers atop the third layer of ophthalmic plastic because that is the conventional method for

constructing such a mirror and because more than six layers provide optimum UV blocking, as taught by Sternbergh.

In regard to claim 14, in the Johansen sunglass lens, the third and fifth ophthalmic plastic layers are CR-39® plastic (col. 16, lines 30-35).

In regard to claim 16, in the Johansen sunglass lens, the third and fifth ophthalmic plastic layers are colorized with a high-contrast blue-blocking amber tint, that limits average blue light transmission of said lens to less than 0.4% (as explained in the rejection of claim 1, above, combination dye 18 with a cut-on wavelength of 550 nm, when combined with a polarizing film, limits average blue light transmission of the lens to 0.23%)

19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh and further in view of Larson (6,334,680, of record) and further in view of Evans et al. (6,220,703, of record) and further in view of Gupta et al. (5,702,819, of record). Base claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen et al. in view of Sternbergh, Larson, and Evans for the reasons set forth above. However, Johansen does not disclose that the third and fifth ophthalmic layers are polycarbonate.

Larson discloses a coated, tinted ophthalmic lens that is constructed with a polarizing film between layers of polycarbonate (col. 5, lines 55-60). Furthermore, Gupta teaches that polycarbonate provides impact resistance (col. 1, lines 36-37). Therefore, it would have been obvious to one of ordinary skill in the art to form the lens of Johansen in view of Sternbergh,

Larson, and Evans with third and fifth ophthalmic layers that are polycarbonate, as disclosed in Larson, because polycarbonate would provide impact resistance, as taught by Gupta.

Response to Arguments

20. On page 16 of Applicant's amendment dated January 20, 2004, Applicant says that he is enclosing a sample pair of sunglasses bearing the lens recited in claim 1. Applicant also says that he is enclosing a letter from one of the named inventors to a business consultant outlining the superior comparative performance of the lens relative to other commercial brands.

21. In regard to the sample pair of sunglasses, models or exhibits are generally not admitted as part of an application or patent unless the requirements of 37 CFR §1.91 are satisfied (MPEP 608.03). The following is a quotation of 37 CFR §1.91:

37 CFR 1.91. Models or exhibits not generally admitted as part of application or patent.

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

(1) Substantially conforms to the requirements of §1.52 or §1.84;

(2) Is specifically required by the Office; or

(3) Is filed with a petition under this section including:

(i) The fee set forth in §1.17(h); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

The sample pair of sunglasses cannot be admitted under any of the above provisions. It does not conform to the requirements of §1.52 or §1.84 because it is not a paper or compact disc, and it is not a drawing or a photograph; it has not been specifically required by the Office; and it is not filed with a petition under 37 CFR §1.91 that includes the fee and an explanation of why entry of the exhibit in the file record is necessary to demonstrate patentability. Therefore, the sample pair of sunglasses is not admitted as part of the application.

22. In regard to the letter from one of the named inventors (understood as the current Applicant Ishak, because he is only named inventor) to a business consultant, any evidence submitted to traverse a rejection on a basis not otherwise provided for must be by way of an oath or declaration under 37 CFR §1.132. The following is a quotation of 37 CFR §1.132:

37 CFR 1.132. Affidavits or declarations traversing rejections or objections.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

The letter is apparently submitted to traverse the rejections under 35 U.S.C. §103(a). However, it is not submitted by way of an oath or declaration. Therefore, it does not meet with the requirements of 37 CFR §1.132 and cannot be considered.

23. Applicant's arguments, in Remarks, filed January 20, 2004, with respect to the rejection under 35 U.S.C. § 112, first paragraph, because the disclosure is not enabling in the absence of disclosure of the tints, or of a supplier and identification of the lens blanks, have been fully

considered and are persuasive. The rejection of claims 1, 3, 4, 6, 7, 10, 12, and 14-16 has been withdrawn. However, the amendment of the claims submitted January 20, 2004, has raised new grounds for rejection under 35 U.S.C. § 112, first paragraph, as detailed above.

24. Applicant argues on page 18 that Johansen et al. '748 does not teach any particular tints for either of the two lens layers, and on page 19, line 3 that the combination of references lacks the particular amber tint of both lens layers. However, as explained above, Johansen discloses the particular tints that form combination dyes 18 in Table 3 and col. 20. Johansen further discloses that both plastic layers are colored with the dye (col. 19, lines 66-68).

25. Applicant argues on page 18 that the rejection of claim 1 is a piecemeal reconstruction of the prior art patents in the light of applicant's disclosure.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As explained in the rejection of claim 1 above, Sternbergh discloses providing a dielectric mirror coating on a sunglass lens in which the substrate can be colored plastic. Motivations for combining the teachings of Johansen and Sternbergh are found in Johansen's teaching that blocking blue light is beneficial, as well as in knowledge of the long-term stability of the type of dyes disclosed in Johansen.

Applicant argues that the combination falls short of teaching how to incorporate a dielectric mirror in the particular sandwich configuration of the present invention. However, Sternbergh discloses providing the dielectric mirror as a coating outside the substrate lens. The Johansen lens is has a sandwich configuration as recited in claim 1. Therefore, with the Johansen lens as the substrate for the Sternbergh coating, the configuration taught by the combination of Johansen and Sternbergh is the configuration recited in claim 1.

Applicant argues that the combination of references fails to teach how to incorporate a dielectric mirror with a sandwich lens in such a way as to produce a balanced light transmission profile. However, if "balanced" means having sufficient transmission in the visible region, applicant's lens fails as well as, shown by Fig. 4 of the current application, in which the amber lens is disclosed to have failed the ANSI Z80.3 test in the red, yellow, and green regions.

Applicant argues on pages 18-19 that there are thousands of potential lens configurations and tint combinations and that therefore it would take prolonged experimentation to arrive at the present invention. However, as explained above, the configuration taught by the combination of Johansen and Sternbergh is the configuration recited in claim 1. Also, the tint disclosed in Johansen meets the recited limitation "high-contrast blue-blocking amber tint", as shown by Figures 1 and 2 of Johansen and by the disclosure in Fig. 3 and col. 20, lines 57-62 that the tint is made from a one to one mixture of red and orange dyes. Furthermore, Johansen discloses in Table 3 that the supplier of the dyes is the Sidney Springer Dye Co. of Los Angeles, CA and that the supplier identifies the dyes as orange 3 and red 2.

Further in response to applicant's argument that there are thousands of potential tint combinations and that therefore it would take prolonged experimentation to arrive at the present

invention, this argument contradicts applicant's arguments in response to the rejection of all the claims under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. On page 13, applicant asserts that no experimentation is necessary to arrive at the tint of the present invention because a lens blank with the recited tint can be ordered from any lens supplier by specifying blue-blocking amber tint. This argument was found persuasive, as explained above. It is therefore not persuasive for applicant to argue that Johansen does not provide sufficient disclosure of the particular amber tint necessary to perfect the transmission profile recited in claim 1.

26. Applicant argues on page 19 that the rejection of claim 10 is a piecemeal reconstruction of the prior art patents in the light of applicant's disclosure. Applicant supports this argument by pointing out that Larson '680 proposes a hydrophobic overcoat for a lens wafer containing neodymium, which would have different optical properties from those recited.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, it is not necessary for a rejection based on the combination of Larson with Johansen that Larson disclose recited amber tint because the tint is disclosed in Johansen. Furthermore, the motivation for combining the transparent, hydrophobic overcoat of Larson with the Johansen lens is to make it easier to clean the lens, as taught by Larson. Therefore, it is not relevant that the optical properties of the Larson lens are different from those recited in claim 10 and achieved by the Johansen lens.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen, Ph.D., J.D., whose telephone number is (571) 272-2336. The examiner can normally be reached on Monday-Friday, from 10:00 a.m. to 3:00 p.m. Eastern Standard Time (a part-time schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The USPTO central official fax number is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. EBC representatives can be reached at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. Additional information is available on the Patent EBC Web site at: http://www.uspto.gov/ebc/index.html.

dar

Scott J. Sugarman
Primary Examiner